

Application No. 09/858,385
Amendment dated October 11, 2006
Reply to Office Action of August 17, 2006

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REMARKS

The Applicant has now had an opportunity to carefully consider the remarks presented in the Office Action mailed August 17, 2006. Reexamination and reconsideration of the application are respectfully requested. Claims 1-11, 36 and 37 remain in the application. Claims 12-35 have been canceled.

The Office Action

Claims 1, 2 and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin (U.S. Patent Application 2005/0015392) in view of Takeda (U.S. Patent No. 5,485,282).

Claims 3-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin, in view of Takeda, and further in view of Yankovich (U.S. Patent No. 6,704,906).

Claims 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tonkin in view of Takeda, in further view of Simpson (U.S. Patent No. 6,559,965) and Matsuo (U.S. Patent No. 6,775,729).

Interview of 10/4/2006

On October 4, 2006, Applicants conducted a telephone interview with Examiner Ries and Primary Examiner Bashore. In this interview, the Applicant and the Examiners agreed on additional claim language that helps to more clearly define over the Takeda reference. These changes have been embodied in claim 1.

The Takeda Reference

Takeda describes several situations of communicating fax machines. The idea of Takeda is to get an intelligible document from the receiving fax machine even though it is not configured the same way as the sending fax machine. When the sending fax machine is being used, a document is read by a reader 6, stored in a memory 7 then analyzed by an identifier 9. This identification informs the sending fax machine the size of the paper being used. This is then communicated to the receiving fax machine so that it will know on which type of paper to print the received document. If the receiving machine is capable of

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printing the size image that the sending machine is about to send, it reports that to the sending machine, and the document is sent. This process encompasses embodiments 1 and 2 or Takeda and assumes that both the sender and receiver have table 100 or 200.

In the third embodiment, Takeda assumes that the receiving fax machine is incapable of printing the desired size. The sending fax machine tells the receiving machine the size of the paper. The receiver responds with a NSC (non-standard capability) message stating that it cannot print that paper size. The sending machine then changes the paper size to one the receiver can accommodate. (See col. 6, lines 35-43, col. 6, lines 58-59, and FIG. 7, steps S20, S21) In the fourth embodiment, the sending machine forces the receiving machine to add the paper size to its list of capabilities.

Finally, in the fifth embodiment, the Sending machine picks a size that the receiving machine can accommodate. The difference between embodiments 3 + 4 and 5 is that the receiver picks the size in 3 and 4, and the sender picks the size in the fifth embodiment.

Takeda is about accommodation. If the receiving fax machine cannot handle a certain paper size, then Takeda changes the transmission to a size it can handle.

The Claims Distinguish over the References of Record

As previously discussed, Takeda changes the transmission size of the fax so that the receiving fax machine can print it out. The present application, in contrast routes the job to printers and finishers that can handle the job; it does not change the parameters of the job like Takeda does. **Claim 1** calls for selecting one of a set of document forms that conforms to the permanent, temporary, and capability restraints of the printers and finishers. ("Document form" is defined on page 15 of the original specification.) In other words, if a certain document creation form will not result in the creation of a desired document, the present application picks a different form that will. The combination of Tonkin and Takeda, in contrast, does not select a new form, that is, Takeda does not select a new path. Takeda changes the job, instead of changing the path.

To illustrate, imagine that a job is to be printed on A4 paper. Printer A is out of A4 paper (a temporary constraint). The present application would choose a path (form) that does not involve printer A. Instead, the present application would send the job to printer B,

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which has A4 paper. The combination of Tonkin and Takeda, in contrast, upon discovering that Printer A is out of A4 paper, would instruct Printer A to print the job on 8½ by 11 paper. Takeda settles for something that the receiving machine can do, rather than choosing a path of machines that can perform the job as ordered. Thus, it is respectfully submitted that **claim 1**, as well as **claims 2-11, 36, and 37** distinguish patentably and unobviously over the references of record.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-11, 36 and 37) are now in condition for allowance. In the event that the Examiner considers personal contact advantageous to the disposition of this case, she should feel free to call Patrick R. Roche, at telephone number (216) 861-5582.

Respectfully submitted,

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